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10/561,450

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Masayoshi Handa

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2292 7590 06/11/2009
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EXAMINER

BUIE, NICOLE M

ART UNIT

PAPER NUMBER

1796

NOTIFICATION DATE

DELIVERY MODE

06/11/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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ADVISORY ACTION

Response to Arguments

Applicant's arguments filed 05/18/2009 have been fully considered but they are not persuasive. The following comments apply:

A) Applicants' argument that the problem solved by the invention is always relevant (P3) is not persuasive. Although the prior art teaches that the aminocarboxylic acid-based metal chelating agent is added to the composition for a different reason than the Applicants, it does not negate the fact that the secondary reference provides a clear rationale for the incorporation of this material. Since similar amounts of this chelating agent is taught in the prior art, the properties would be inherently present in the composition of modified Obayashi et al.

B) Applicants' showing of unexpected results (P3-4) is not persuasive. Although the examples in the instant specification show that the aminocarboxylic acid-based metal chelating agent improves light resistance, this effect is expected. As mentioned in the previous action, Miyake et al. (US 2001/0053807) teaches a water-absorbent resin composition which contains comparable amount of aminoacetic chelating agent has excellent light resistance [0010], and thus, the additional benefit of discoloration resistance imparted by the metal chelator does not go unrecognized in the prior art.

C) Applicants' argument that Hosokawa '826 does not disclose aminocarboxylic chelating agents (P4) is not persuasive. Hosokawa teaches aminocarboxylic chelating agents [0071].

D) Applicants' argument that Hosokawa '826 does not teach the claimed properties (P4) is not persuasive. Since the prior art composition has the same components as the claimed

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invention, the claimed properties would be inherently present in the composition of the prior art. Furthermore, since Obayashi et al. or Hosokawa et al. do not teach or suggest nitrilotriacetic acid as a required component in the prior art composition, the aminocarboxylic chelating agent would achieve the results as evidenced by Hosokawa.

E) Applicants' argument that it is not clear that component (B) of Hosokawa '826 or the amount of component (A) contributes to gel stability, or the actual combination thereof (P4) is not persuasive. Component (A) is basically the gel-forming material.

F) Applicants' argument of hindsight (P5) is not persuasive. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

G) Applicants' argument about Miyake (P5-P6) is not persuasive. Miyake does not have to be included in the statement of rejection insofar as the other references teach all of the limitations and Miyake was cited merely to answer Applicants' assertions of unexpected results. In connection with this it should be emphasized that the Examiner has not dismissed Applicants' explanation of unexpected results but, rather, believes simply that that the record reflects that said results are not unexpected.

H) Applicants' argument that Miyake discloses that light resistance is exhibited by the amount of impurity (nitrilotriacetic acid) (P6) is not persuasive. Paragraphs [0146-0149] do

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NOT indicate that what is being measured is the amount of impurity in the chelating agent. It says only that the lower the extractable content, the higher the light resistance. The source of the extractable content is unclear and may just as plausibly represent that portion of the gel which was decomposed by light.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NICOLE M. BUIE whose telephone number is (571)270-3879. The examiner can normally be reached on Monday-Thursday with alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Eashoo can be reached on (571)272-1197. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. M. B./
Examiner, Art Unit 1796
5/25/2009

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/Marc S. Zimmer/

Primary Examiner, Art Unit 1796